

REMARKS

This submission is in response to the rejection issued by the USPTO on August 7, 2009 in which it asserted that claims 9 and 20-22 are obvious under 35 USC 103. Claims 9 and 20-22 remain in the application and have not been amended with this submission.

SECOND REQUEST TO CORRECT PRIORITY CLAIM

Before addressing the rejection issued by the USPTO, the undersigned would like to draw the USPTO's attention to the priority date that should be accorded to this application. In the USPTO's communication of October 16, 2008, it stated that the instant application was entitled to a filing date of January 22, 2004 (the filing date of PCT/IB04/00240).

In Applicant's previous submission of March 6, 2009, the undersigned pointed out that this was in error and requested that the USPTO correct its records, including the data provided by PAIR. As was explained in that submission, Applicant's previous counsel had filed a preliminary amendment claiming priority to United States Provisional Application Serial Number 60/444,496 (having an effective filing date of February 3, 2003). A copy of this amendment, with the USPTO's date stamp, was included to document its receipt by the USPTO. Likewise, a review of PAIR shows a preliminary amendment was filed for this application on July 29, 2005; in which the specification was amended to include a claim to a priority date of February 3, 2003.

As the undersigned pointed out on March 6, 2009, this preliminary amendment was filed in a timely manner as required by 37 CFR 1.78(a) (2) and (a) (5). It was submitted on July 29, 2005, the date the application entered the national phase in the United States, well within the 4 month deadline now imposed by the USPTO.

The undersigned would also like to call the USPTO's attention to the NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 and 37 CFR 1.495 dated August 11, 2006 that was issued by the USPTO. This document states the instant application is entitled to a priority date of February 3, 2003.

In its communication of August 7, 2009, the USPTO did not address the undersigned's request for correction. Along with a notice of allowance, the undersigned requests that this correction occur.

REJECTION UNDER 35 USC 103

Claims 9 and 20-23 were rejected under 35 USC 103 as being obvious over Hu when combined with the '438 application and the '485 application. The USPTO has asserted that Hu discloses a formulation containing 4-cyclopentyl resorcinol in combination with ethanol and propylene glycol. The USPTO asserts that the '438 application is prior art against the instant application and discloses topical compositions containing penetration enhancers such as dimethyl isorbide (see paragraph 55). The USPTO also asserts that the '485 application is entitled to an effective filing date of November 29, 2002 and discloses that hexylene glycol and propylene glycol are penetration enhancers (see claim 28). The USPTO further asserts it would have been obvious to incorporate the penetration enhancers of the '485 and '483 applications into the composition of Hu.

The undersigned does *not* dispute that Hu discloses 4-cyclopentyl resorcinol in an admixture of ethanol and propylene glycol. However the undersigned **does dispute** the USPTO's characterization of both the '485 and '483 applications. It is respectfully submitted that the USPTO's assumption that the documents qualify as prior art against the pending application is factually flawed.

As noted above, the instant application is entitled to an effective filing date of February 3, 2003. United States Provisional Application Serial Number 60/444,496 discloses a composition as described by claims 9 and 20-22 (see page 38, Table 2). The '438 application was not filed until September 18, 2003. The '438 application does claim priority to a provisional filed in 2002, serial number 60/412,381. However a review of the '381 provisional shows that it does not contain paragraph 55, which the USPTO is basing its rejection upon. Thus the '438 application does not qualify as prior art against the instant application.

The same rationale is equally applicable to the '485 application, which claims priority to a provisional filed November 20, 2002 (United States Patent application serial number 60/429456). A review of the '456 provisional shows that claim 28, which the USPTO was using to support its obviousness analysis, is not present. Further, the provisional does not contain any disclosure relevant to penetration enhancers. All of the other priority dates that the '485 refers to are after February 3, 2003. Thus the '485 application does not qualify as prior art against the instant application either.

While Hu qualifies as prior art against the instant application, the secondary references do not. Thus, the obviousness analysis made by the USPTO is factually

flawed and should be withdrawn. Reconsideration and an allowance is respectfully requested.

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